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PATENT

Express Mail No. EV 621121840 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Robert A. Holton
Serial No. 10/676,222
Filed October 1, 2003
Confirmation No. 9712
For TAXANES HAVING A C10 ESTER SUBSTITUENT
Examiner Amelia A. Owens

Art Unit 1625

November 14, 2005

RESPONSE TO ELECTION OF SPECIES

TO THE COMMISSIONER FOR PATENTS,

SIR:

This Letter is in response to the Office action mailed September 12, 2005, in which an election of a single disclosed species for prosecution on the merits was requested. Although the Office may also have intended to restrict the present claims, for the reasons discussed herein, the Office failed to satisfy any of the requirements for restriction.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. According to MPEP §808, "[e]very requirement to restrict has two aspects: (A) the reasons (*as distinguished from the mere statement of conclusion*) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween..." (emphasis added). Further, "the particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. *A mere statement or conclusion is inadequate*" (emphasis added). In this particular instance, the Office has failed to provide any reasons whatsoever. Instead, as expressly prohibited, the Office merely concludes that the application "contains claims directed to the following patentably distinct species of the claimed invention..." page 2 of Office action mailed September 12, 2005.

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Furthermore, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP §803. No showing has been made by the Office that the search and examination of this entire application will require serious burden. Thus, the Office has failed to adhere to any of the rules/guidelines for setting forth a proper restriction requirement.

Subject to the foregoing traverse, applicants elect the compounds of group (2) where at least one of X_3 , X_{10} , and R_{10a} is heterocyclic. Consistent with this election and in response to the Examiner's request to elect a single disclosed species pursuant to 35 U.S.C. §121, applicants hereby elect compound no. 3102 found in Example 2, at page 31, where, based on structure (1) at page 2 of the specification,

R_2 is benzoyloxy;
 R_7 is hydroxy;
 R_{10} is $R_{10a}COO^-$;
 R_{10a} is cyclopropyl;
 R_{14} is hydrido;
 X_3 is 2-furyl;
 X_5 is $-COOX_{10}$; and
 X_{10} is isobutyl.

Claims 1-4, 6-8, 10-12, 14-16, 18-20, 22-24, 26-28, 30-32, 34-36, 38-40, 42-44, 46-48, 50-52, 54-56, 91-93, 95-96, 98-100, 102-103, 109-111, 113-115, 127-131, 137-139 and 150 read on the elected species.

According to MPEP §809.02(c), an examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species and according to MPEP §809.02(e), whenever a generic claim is found to be allowable in substance, action on the species claims shall thereupon be given as if the generic claim were allowed. Thus, if it is determined that the elected species is

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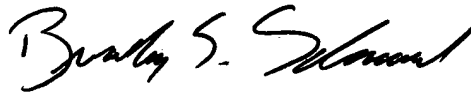
patentable, it is incumbent upon the Office to search additional species that fall within any allowable generic claims.

Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

Enclosed is applicant's check in the amount of \$120 for a one month extension of time as required under 37 C.F.R. §1.136(a).

The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

Respectfully submitted,



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BSS/vlm
*Enclosure